REMARKS

This is in response to the office action dated October 25, 2011, which rejected all pending claims as unpatentable over one or more references under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). This paper requests that an RCE be established to continue prosecution of this case.

Interview with the Examiner

On November 22, 2011 Applicants had a telephone interview with Examiner Lanier on this application and other pending related applications. On November 29, 2011 a further telephone interview was held. Applicants thank Examiner Lanier for the courtesies shown in discussing the matters under examination. A further interview was held on December 8, 2011. No agreement is reached as to allowance of the rejected claims. At the third interview, Applicants informed the Examiner of their election to file an RCE.

Amendments to the Claims

Claims 1-44 are canceled and new claims 45-61 are added. Of these, Claims 45 & 53 are independent claims. Features of canceled claims 24 & 32 are recited in these independent claims in a revised form. However, in order to clarify the features and to obtain priority date to the parent application, the following steps of Claim 24 (new claim 45) are deleted and presented in a dependent form as Claim 48, which depends from new claim 45:

> examining license information for the copyright-protected information object to determine a number N (where N ≥ 1) of simultaneous users who could access the copyright-protected information object; and
>
> allowing no more than N simultaneous users to access the copyright-protected information object.

Likewise, dependent claims 49 and 50 recite some steps of the now canceled claims in a dependent form. Claim 53 is directed toward a server computer. Support exists in the Specification for this recitation. New Claim 61 recites that the user computer with which the

server computer interacts is one of a specific types of computers. Support for this recitation is in the Specification at page 11, lines 11-23.

No new matter is added as a result of the amendments. Examiner is respectfully requested to review and enter the amendment.

Description of "multimedia" content in the parent application

The office action of October 25, 2011 states, "However, the online repository described in the '796 application does not store multimedia content." See page 2, ¶ 2 of the Office Action. But the '796 application states:

> It should be noted that the user's social security number or alias can illustratively be used as primary keys to access the information from the tables. Other methods, such as date of birth, mother's maiden name, finger print scan, retina scan, or a combination of these methods can be used in other embodiments. The types of fields used in the illustration include Number [0-9]; Character [A-Za-z0-9 and other special characters such as ASCII characters]; and multimedia methods of storage for other types of data.

See Ser. No. 09/478,796, at page 8, line 25 to page 9, line 2 (underline added). Examples are given for different types of data formats: social security number may be represented via regular expression [0-9], mother's maiden name may be represented via the expression [A-Za-z0-9 and other special characters such as ASCII characters] and "multimedia methods of storage" may be used to represent "finger print scan, retina scan, or a combination of these methods." It appears that the office action overlooked this description of the Specification. Reconsideration is respectfully requested.

Meyer is antedated by the parent application regarding controlling use of a copyrighted information object

As to Meyer, the office action appears to have overlooked that Ser. No. 09/478,796 described copyrighting information objects and using copyrighting to control the use of the

information objects. See Ser. No. 09/478,796 at page 18, lines 18-22, which states:

> Preferably, the requester 105 is forbidden from reselling or retransmitting the information, or using it beyond an expiration date set either by the user 103 or by the PIRSP. 20 Preferably, to ensure this, information objects are copyrighted or otherwise contractually protected. Further, this could be a selling point to users, since the PIRSP not only guarantees the safety of the stored information, but in addition controls how this information is used.

Thus, the parent application has precedence over Meyer for controlling the use of information via copyright. The parent application also describes some methods of such control – forbidding use of the information beyond an expiration date, resale of the information object, retransmission of the information object. Examiner is respectfully requested to reconsider.

Glassman is not a pertinent reference

The Glassman reference is not pertinent because (a) Glassman teaches away from the instant claims under examination, and (b) Glassman's lock server requires a combination of a "specialized lock server and a client program."

A. Glassman teaches away from the claimed combination

A reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In *Ex parte Thusoo* (BPAI No. 2009-012801, App. Ser. No. 10/662,095, Decision date 10-24-2011) a reference was found to "teach away" when it used limiting words which were meant to discourage combination:

> Moreover, since this explicit disclosure in Reference [A] uses restrictive words such as "only" and "exactly," we find that an ordinarily skilled artisan would have been discouraged from modifying the RETURNING clause to include the ability to operate on separate rows (i.e., return values from separate rows when a value in each row has been inserted, updated, or deleted).

(Underline added). See also, "Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*" citing as Example 4.6 the case *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314 (Fed. Cir. 2009), in which case the Court stated:

> Here, Medtronic asserts that achieving a rigid pedicle screw was itself the reason to combine Puno and Anderson. In rebuttal, DePuy argues, and the district court found, that Puno "teaches away" from a rigid screw because Puno warns that rigidity increases the likelihood that the screw will fail within the human body, rendering the device inoperative for its intended purpose. Ensnarement Order, 526 F. Supp. 2d at 172. The district court thus found that Puno's teachings undermine the very reason Medtronic proffers as to why it would have been obvious to combine Puno and Anderson, viz., the creation of a rigid screw.

DePuy Spine, 1326-27. (Underline added). There is a difference between "teaching" and "teaching away." Both may describe an method or a possible combination, but in the latter, a statement limiting the use of the method or combination will effectively discourage a person of skill from pursuing the described path. It is the criticism or discouragement or limited applicability of the reference that makes it "teaching away." See *In re Kahn,* 441 F.3d 977, 990 (Fed. Cir. 2006).

The clear language of Glassman is that the existing lock servers would not work with an open network because an open network has additional requirements such as an unlimited number of potential users. To solve this problem, Glassman invented what is termed as "license scrip", which appears in its function akin to a ticket used to enter a movie theater. The instant claims are directed to providing access to the copyrighted information objects to account-holding users, whereby the server computer is aware of the users who seek access. Glassman therefore attempted to solve a fundamentally different problem.

B. Glassman's "lock server" requires interaction with a "client program"

Glassman states:

> In existing systems, the license control is performed by a combination of a specialized lock server and a client program. The lock server validates users' requests for access to the content and maintains the status of active users. The client program interacts with the lock server to acquire a lock and to provide access to the content.

See Glassman, (USP 6,453,305) at Col. 1, line 66-Col. 2, line 4. Glassman is not apposite to invalidate claim 24 because Glassman requires a "client program [that] interacts with the lock server to acquire a lock and to provide access to the content." Therefore Glassman should be discarded as a reference. Reconsideration is respectfully requested.

Examiner is requested to make factual findings to support a prima face case of obviousness

The office action states, at page 13, ¶ 19, that:

> Manolis does not disclose that the images can be copyrighted images that are bound by license restrictions. Glassman discloses providing licensed access to copyrighted content for a period of time (Abstract & Col. 1, lines 42-50)....
>
> * * *
>
> It would have been obvious to one of ordinary skill in the art at the time the invention was made for the online print service of Manolis to provide licensed access to copyrighted images in order to provider account users with the ability control access to their copyrighted images at the same time providing concurrent access to the images as suggested by Glassman (Col. 1, lines 55-62 & Col. 2, lines 27-31).

MPEP § 2141 III requires a "clear articulation of the reason(s) why the claimed invention would have been obvious". See also, *In re Kahn,* 441 F.3d 977, 988 (Fed. Cir. 2006). Applicants believe that the office action does not make factual findings sufficient to justify the combination of Manolis with Glassman. Therefore Applicants respectfully request the Examiner to set forth such findings in view of the above arguments.

Conclusion

Apart from the RCE filing fee, no additional fee is believed to be due with this response. Examiner is respectfully requested to proceed with further examination.

Respectfully Submitted,

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